

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

EXPERIENCE HENDRIX, L.L.C., a
Washington Limited Liability Company, and
AUTHENTIC HENDRIX, LLC, a
Washington Limited Liability Company,

Plaintiffs,

v.

HENDRIXLICENSING.COM, LTD, dba
HENDRIX ARTWORK and
HENDRIXARTWORK.COM, a Nevada
Corporation, and ANDREW PITSICALIS
and CHRISTINE RUTH FLAHERTY,
husband and wife,

Defendants.

No. C09-285Z

ORDER

THIS MATTER comes before the Court on cross-motions for partial summary judgment, docket nos. 60, 64, and 67. By Minute Order dated August 17, 2010, docket no. 88, the Court directed the parties to provide supplemental briefing on issues relating to the cross-motions for partial summary judgment. After reviewing those submissions, the Court certified to the Washington State Attorney General, pursuant to Federal Rule of Civil Procedure 5.1(b), that a constitutional challenge to a state statute, namely the Washington Personality Rights Act ("WPRA"), RCW Chapter 63.60, has been made in this case. See Notice dated September 1, 2010 (docket no. 91). The Washington State Attorney General

1 has elected not to intervene in this case. Notice dated October 26, 2010 (docket no. 101).
2 Pursuant to the Court's instructions, the parties filed additional briefing concerning whether
3 the WPROA would be constitutional if interpreted as a "statutory directive" to apply
4 Washington law in determining if Jimi Hendrix's right of publicity survived his death and
5 passed to his heir. Having reviewed all papers filed in connection with the cross-motions for
6 partial summary judgment, the Court enters the following Order.

7 **A. Plaintiffs' Motion for Partial Summary Judgment (docket no. 60)**

8 Plaintiffs Experience Hendrix, L.L.C. and Authentic Hendrix, LLC (collectively,
9 "Experience") move for partial summary judgment on one of their six causes of action,
10 namely violation of the Washington Consumer Protection Act ("CPA"). The Court
11 previously granted partial summary judgment in favor of Experience with regard to a
12 different cause of action, namely trademark infringement, but only in connection with
13 Pitsicalis's inclusion of Experience's registered marks within business names (*i.e.*, "Hendrix
14 Licensing," "Hendrix Artwork") and uniform resource locators ("URLs") (*i.e.*,
15 "www.hendrixlicensing.com," "www.hendrixartwork.com") and with Pitsicalis's use, as
16 brands or marks, of the "guitar and headshot" logo and of Jimi Hendrix's signature. *See*
17 Order (docket no. 57). Experience did not move for, and the Court did not grant, partial
18 summary judgment as to Pitsicalis's use of the names "HENDRIX" or "JIMI HENDRIX,"
19 which might constitute nominative fair use. *See* Order at 3-10 (docket no. 27). Relying on
20 the Court's earlier ruling concerning trademark infringement, Experience now moves for
21 partial summary judgment on the CPA claim.

22 Experience, however, has not demonstrated an absence of "genuine dispute as to any
23 material fact" relating to the CPA claim and, thus, Experience's motion for partial summary
24 judgment must be denied. *See* Fed. R. Civ. P. 56(a) (2010). To establish a violation of the
25 CPA, a private plaintiff must prove (i) the defendant engaged in an unfair or deceptive act or
26 practice; (ii) such act or practice occurred within a trade or business; (iii) such act or practice

1 affected the public interest; (iv) the plaintiff suffered an injury to his or her business or
 2 property; and (v) a causal relationship exists between the defendant's act or practice and the
 3 plaintiff's injury. *Hangman Ridge Training Stables, Inc. v. Safeco Title Ins. Co.*, 105 Wn.2d
 4 778, 785-93, 719 P.2d 531, 535-39 (1986). A plaintiff can establish that a trade practice is
 5 per se unfair or deceptive by showing it violates a regulation or statute defining such practice
 6 as unfair or deceptive. *Id.* at 786. In the alternative, a plaintiff can demonstrate that a trade
 7 practice is unfair or deceptive by proving it had the "capacity to deceive a substantial portion
 8 of the public." *Id.* at 785. Experience asserts that courts "in the Western District have
 9 uniformly held that trademark infringement also constitutes a violation of the CPA," Motion
 10 at 7 (docket no. 60), relying on two cases, *Sleep Country USA, Inc. v. Nw. Pac., Inc.*, 2003
 11 WL 23842534 (W.D. Wash.), and *Lahoti v. Verichack, Inc.*, 708 F. Supp. 2d 1150 (W.D.
 12 Wash. 2010). To the extent Experience contends that trademark infringement is per se unfair
 13 or deceptive, neither of these cases provides support.

14 In *Sleep Country*, the court held that, because the defendant was liable for trademark
 15 infringement, it was also liable for violation of the CPA, citing *Nordstrom, Inc. v.*
 16 *Tampourlos*, 107 Wn.2d 735, 733 P.2d 208 (1987), for support. 2003 WL 23842534 at *7.
 17 In a case subsequent to *Nordstrom*, however, the Washington Supreme Court made clear that
 18 trademark infringement does not necessarily establish a violation of the CPA:

19 While we have eschewed the use of judicially created per se violations of the
 20 Consumer Protection Act . . . , we nevertheless recognize that certain acts, by
 21 their very nature, must fulfill certain prongs of the *Hangman Ridge* test. This
 22 is true of the typical trade name infringement case. . . . *We emphasize that this*
is not a per se rule, but rather a function of what we perceive as the
 overlapping nature of proof in both trade name infringement cases and
 Consumer Protection Act violations.

23 *Seattle Endeavors, Inc. v. Mastro*, 123 Wn.2d 339, 350, 868 P.2d 120 (1994) (emphasis
 24 in original, quoting *Nordstrom*, 107 Wn.2d at 742-43). In *Seattle Endeavors*, the
 25 Washington Supreme Court concluded that, because the mark at issue was weak and the
 26 infringement was inadvertent, the plaintiff had failed to establish the elements of a CPA

1 claim. 123 Wn.2d at 350-51. Thus, Seattle Endeavors precludes any contention that
2 trademark infringement constitutes a per se violation of the CPA.

3 Likewise, Lahoti does not support a per se argument. Contrary to Experience's
4 assertion, the Lahoti court did not simply rest on a finding of trademark infringement, but
5 rather the court, citing Nordstrom and Seattle Endeavors, made amended findings, after a
6 bench trial and following remand from the Ninth Circuit, of both a strong, inherently
7 distinctive, mark and intentional infringement before concluding that the defendant was
8 liable for violating the CPA. 708 F. Supp. 2d at 1168. Unlike the court in Lahoti, this Court
9 is confronted with a motion for partial summary judgment, as to which the Court may not
10 weigh the evidence or render findings concerning disputed facts. The Court is not persuaded
11 that Experience has established, as a matter of law, that Pitsicalis engaged in an unfair or
12 deceptive act or practice or that Experience suffered any injury causally related to Pitsicalis's
13 allegedly unfair or deceptive act or practice. Experience's motion for partial summary
14 judgment is therefore DENIED.

15 **B. Defendants' Motion for Partial Summary Judgment (docket no. 67)**

16 **1. Claims Against Christine Flaherty**

17 Defendant Christine Flaherty is married to Andrew Pitsicalis. Experience concedes
18 that the claims against Ms. Flaherty do not allege any individual liability, but rather are
19 directed at the marital community. See Response at 24 (docket no. 81). Thus, defendants'
20 motion for partial summary judgment is GRANTED in part, and plaintiffs' claims against
21 Ms. Flaherty are DISMISSED with prejudice.

22 **2. Damages and Attorney Fees**

23 Pitsicalis contends that Experience is not entitled to damages in connection with the
24 trademark infringement claim, on which the Court has already resolved in part the issue of
25 liability, absent a finding of willfulness. The Lanham Act indicates otherwise. Under 15
26 U.S.C. § 1117(a), for a violation of § 1125(a), a plaintiff may recover, subject to the

1 principles of equity, the defendant's profits, the plaintiff's actual damages, and the costs of
2 the action. In determining profits, the plaintiff must prove the defendant's sales, but the
3 defendant must establish by a preponderance of the evidence all elements of cost or
4 deduction. The Court may also, in exceptional cases, award reasonable attorney fees to the
5 prevailing party. The Court is satisfied that whether Pitsicalis's costs equaled or exceeded
6 sales, whether the principles of equity would warrant an award of profits, if any, to
7 Experience, and whether this case is exceptional for purposes of attorney fees, are questions
8 of fact. Thus, defendants' motion for partial summary judgment is DENIED in part with
9 respect to damages and attorney fees relating to plaintiffs' infringement claim.

10 **3. Remaining Claims and Counterclaims**

11 Pitsicalis has also moved for partial summary judgment as to plaintiffs' claim for false
12 designation of origin and as to two of the six counterclaims, namely the counterclaim for
13 declaratory judgment concerning the inapplicability of the WPRA and the counterclaim for
14 declaratory judgment of non-infringement relating to images and likenesses of Jimi Hendrix.
15 The Court DEFERS ruling on these portions of defendants' motion for partial summary
16 judgment.

17 **C. Counterclaim Defendants' Motion for Partial Summary Judgment**
18 **(docket no. 64)**

19 Experience has moved for partial summary judgment as to the remaining four
20 counterclaims, namely trade libel or defamation, tortious interference with business
21 expectancy, tortious interference with contractual relations, and violation of the CPA. The
22 Court DEFERS ruling on this cross-motion for partial summary judgment.

23 **D. Oral Argument**

24 Oral argument is SCHEDULED for January 12, 2011, at 1:30 p.m. on the
25 constitutionality of the WPRA, as amended in 2008, and the portions of the cross-motions for
26 partial summary judgment not resolved by this Order or prior to the hearing. Each side will

1 have a total of sixty (60) minutes for argument. After argument, the Court will conduct a
2 status conference for the purpose of selecting a trial date and setting related deadlines.

3 **Conclusion**

4 For the foregoing reasons, the Court hereby ORDERS:

5 (1) Plaintiffs' motion for partial summary judgment on their CPA claim, docket
6 no. 60, is DENIED;

7 (2) Defendants' motion for partial summary judgment, docket no. 67, is
8 GRANTED in part, DENIED in part, and DEFERRED in part, as follows:

9 (a) Plaintiffs' claims against defendant Christine Flaherty are DISMISSED
10 with prejudice;

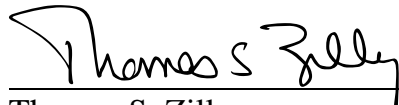
11 (b) Defendants' motion to preclude plaintiffs from seeking damages and
12 attorney fees in connection with their trademark infringement claim is DENIED; and

13 (c) Defendants' motion for partial summary judgment is otherwise
14 DEFERRED;

15 (3) Counterclaim defendants' motion for partial summary judgment, docket no. 64,
16 is DEFERRED; and

17 (4) The Clerk is directed to send a copy of this Order to all counsel of record.
18 IT IS SO ORDERED.

19 DATED this 29th day of December, 2010.

20
21 

22 Thomas S. Zilly
23 United States District Judge
24
25
26